

REMARKS

Claims 22-42 are all the claims pending in the application. Claims 29, 31 and 27 have been amended to delete one embodiment of the substituent J, namely a phenyl group, as disclosed in the specification at page 10, lines 6-10. Accordingly, no new matter is added and entry of the Amendment is requested, respectfully.

I. Office Action Summary

A) Disposition of Claims

Claims 22-42 are pending in the application. Method claims 22-28 are allowed. Compound claims 29-33 and 35-40 are rejected. Compound claim 24 and method claims 41 and 42 are objected to.

B) Information Disclosure Statements

The Examiner has not initialed all references cited on the PTO Forms 1449 filed on March 28, 2005. The Examiner stated that the references were not considered because there were no copies of them filed with the Information Disclosure Statement.

Submitted herewith are additional copies of the references and the PTO date stamped filing receipt indicating that the references were filed. Accordingly, the Examiner is requested to consider the references.

II. Detailed Action

A) Claim Rejections - 35 U.S.C. § 103(a)

Claims 29-33 and 35-40 were newly rejected under 35 U.S.C. § 103(a) as being unpatentable over Bru-Magniez, *et al.* (U.S. Patent No. 5,021,443), Bru-Magniez, *et al.* (U.S.

Patent No. 5,124,336) and Bru-Magniez, *et al.* (U.S. Patent No. 5,128,359), each in combination with Chakravarty, *et al.* (U.S. Patent No. 5,128,327).

As to claim 29, the Examiner asserted that the difference between the compounds of the Bru-Magniez, *et al.* patents and those recited in claim 29 is that the compounds recited in claim 29 define M as a sulfinyl or a sulfonyl group, whereas Bru-Magniez, *et al.* teaches sulfur.

As to claim 31, the Examiner asserted that the difference between the compounds of the Bru-Magniez, *et al.* patents and those claimed in claim 31 is that Bru-Magniez, *et al.* does not teach the substituents X¹ and X².

In order to compensate for this deficiency, the Examiner cited Chakravarty, *et al.* as allegedly teaching the interchangeability of sulfinyl and sulfonyl in a benzimidazole compound and the interchangeability of the benzimidazole core being unsubstituted or substituted with substituents such as those defined by X¹ and X². Further, the Examiner asserted that Chakravarty, *et al.* teach that the compounds are useful for treating diseases, for example, heart failure.

The Examiner concluded that one of ordinary skill in the art would readily substitute a sulfinyl group or a sulfonyl group of Chakravarty, *et al.* for the sulfur atom of Bru-Magniez, *et al.* in order to obtain the compounds of independent claim 29 and claims dependent therefrom, other than claim 34. The Examiner further concluded that one of ordinary skill in the art would readily add X¹ and X² substituents of Chakravarty, *et al.* to the benzimidazole core of Bru-Magniez, *et al.* in order to obtain the compounds of independent claim 31 and claims dependent therefrom, other than claim 34.

For the following reasons, the rejection is overcome.

In relation to J in the instant claims 29-33 and 35-40 the compounds of Bru-Magniez, *et al.* (US Patent Nos. 5,021,443, 5,124,336, 5,128,359) disclose only a phenyl group. However, the instant claims have been amended to delete the embodiment where J is a phenyl group. As a result, the differences between the compounds of Bru-Magniez, *et al.* and the instant claimed compounds are the definition of "M", "J" and part of "X¹ and X²." Furthermore, the activities of the compounds are different. The instant claimed compounds have chymase activity, while those of Bru-Magniez, *et al.* have TXA2 activity. Accordingly, Applicants submit that the invention as now claimed is neither taught nor suggested by the cited references.

Accordingly, the Examiner is requested to reconsider and remove this rejection.

B) Claim Objections

1) Claim 34 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants submit that both claims 29 and 31, from which claim 34 depends, are patentable and request that the objection be removed.

2) Claims 41 and 42 were objected to for containing non-elected subject matter.

It appears that the Examiner considers the method to be the non-elected subject matter. However, since these method claims are limited to the compounds recited in claims 29, 30 or 31, the Examiner is requested to rejoin claims 41 and 42 upon a determination that claims 29, 30 and 31 are allowable.

III. Terminal Disclaimer

Applicants submit herewith a terminal disclaimer with respect to U.S. Application No. 10/963,710, and U.S. Application No. 11/129,508. The '710 application is a continuation of U.S. Application No. 09/743,483. U.S. Application No. 11/129,508 is a continuation-in-part of U.S. Application Nos. 09/743,483 and 10/777,067. In response to an obviousness-type double patenting rejection previously issued, Applicants filed a terminal disclaimer over the '483 application, which has been abandoned.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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